REMARKS

The undersigned representative thanks Examiners Rayyan and Wassum for their courtesies extended during the August 9, 2005 Examiner Interview. As discussed during the Examiner Interview, Privista has assigned two patent applications to Equafax, the assignee of this application. A copy of the Notice of Recordation of Assignment Document ("Notice") is attached to this response (see Attachment A). The Notice shows proof of the assignments from Privista to Equafax. In addition, an Information Disclosure Statement ("IDS") is concurrently submitted with this response. The IDS cites references that have been cited in one of the patent applications that Privista has assigned to Equafax. As requested by the Examiner, the draft response submitted in preparation of the Examiner Interview is being submitted as a response to the outstanding non-final office action. As indicated in the Interview Summary, "In light of Applicant's remarks Applicant has overcome rejections of record."

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks. Claims 1-86 are currently pending. Claims 1-86 are rejected. Claims 1, 5, 12, 19, 22, 26, 41, 42, 47, 48, 56, 57, 65, 66, 70, 71, 76, and 77 have been amended. No new matter has been added.

Summary of Rejections

The Office Action rejected claims 1-86 under 35 USC §112, second paragraph; objected to claims 41-86; and rejected claims 1-86 under 35 USC §103(a) as being obvious in view of various combinations of the following cited art: U.S. Patent Application Publication No. US 2001/0011245 Al to *Duhon* (hereinafter *"Duhon"*); "New Privista Product Provides Early Warning System to Combat Identity Theft ID Guard to Build Consumer Confidence, Save Companies Lost Revenue," October 23, 2000 (hereinafter *"Warning System");* U.S. Patent Application Publication No. US 2002/0133462 to *Shteyn* (hereinafter *"Shteyn"*); U.S. Patent Application Publication No. US 2002/0116322 to *Schnall et al.* (hereinafter, "*Schnall*"); "About ID Guard," January 24, 2001 (hereinafter *"About ID Guard"*); "PrivacyGuard.com," December 11, 2000 (hereinafter *"Privacy Guard");* "Soups Up ID Theft Monitoring Service," January 26, 2001 (hereinafter *"Soups Up");* CreditCheck Monitoring Service, December 11, 2000

(hereinafter *"Credit Check");* and U.S. Patent Application Publication No. US2002/0194143 to *Banerjee et al.* (hereinafter *"Banerjee").*

Rejection of Claims 1-86 under 35 U.S.C. §112, second paragraph

Claims 1-86 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that:

> Regarding the claims the limitation "substantially contemporaneously" is indefinite as to the amount of time that would be considered substantially contemporaneously.
>
> 4. Claim 42 recites the limitation "the first type" in line 1. There is insufficient antecedent basis for this limitation in the claim. (Examiner interprets this claim to depend from claim 41).
>
> 5. Claim 56 recites the limitation "the user file" in line 1. There is insufficient antecedent basis for this limitation in the claim. Examiner interprets this claim to depend from claim 41.

Regarding the "substantially contemporaneously" limitation, the Examiner is respectfully directed to MPEP 2173.05(b) part D, which exemplifies an existing court holding that the term "substantially" – when used to describe a particular characteristic of the claimed invention – can be definite in view of the general guidelines contained in the specification or because one of ordinary skill in the art would know what was meant by such term.

It is respectfully submitted that the phrase "substantially contemporaneously" is definite both in view of the general guidelines contained in the specification ***and*** because one of ordinary skilled in the art would know what was meant by such term. For example, the specification states that a "user may also select frequency of communication. He can choose to be notified ***as soon as a change occurs*** in his credit file or be notified periodically. He may choose even to be notified when he makes an inquiry." (Emphasis added). See last page of the specification. Notification of a user substantially contemporaneously with a change occurrence in the user's credit file permits the user to take early action for a variety of reasons, such as correcting a credit report, or preventing identity theft. See Id. Further, the term "contemporaneous" is commonly

understood and defined in the dictionary as happening, existing, living or coming into being during the same period of time. Thus, one skilled in the art would know what was meant by such term. Any suggestion by the Examiner to rephrase the limitation "substantially contemporaneously" is welcomed for discussion.

Regarding claim 42, this claim is amended to correct a typographical error. Claim 42 is now dependent on claim 41, which was originally intended.

Regarding claim 56, the limitation "the user file" has been changed to "the user" to correct the problem of insufficient antecedent basis as cited by the Examiner.

Hence, for at least these reasons, the undersigned representative requests that the rejection of claims 1-86 under 35 U.S.C. §112, second paragraph, be withdrawn.

Objection of Claims 41-86

Claims 41-86 are objected to. Specifically, the Examiner recites:

> ... regarding the use of first type and second type of modifications, the monitoring system does not have a means of knowing what the change is, it does not distinguish between the first type (erroneous) and second type (change).
>
> Examiner was also unable to locate the reference in the specification to first type of modification, second type of modification and erroneous modification. There is a potential new matter issue.

Claims 41, 42, 47, 48, 56, 57, 65, 66, 70, 71, 76, and 77 have been amended to eliminate "types of modifications," e.g., first type of modification and second type of modification, and similarly recited phrases. In addition, the specification does support monitoring changes to data elements, e.g., erroneous changes and corrections, without regard to type. For example, *inter alia*, "The customer can set criteria for data monitoring. He can identify which changes to his credit file are to be monitored, how and when he is to be notified of any changes." (See application, page 10, lines 6-7). "The customer may also elect to monitor changes to certain data elements in the database 46." (See application, page 10, lines 17-18). Therefore, the customer can be notified when a certain data element change occurs, e.g., an erroneous change, and can be notified when the same data element change occurs, e.g., a correction has been made. For example, a customer can receive a notification that a data element changed, launch an

investigation (see application, page 13, lines 12-15, page 15, lines 2-4, page 22, lines 6-7, page 23, lines 12-14), and receive a notification when the data element changes again.

Hence, for at least these reasons, the undersigned representative requests that the objection to claims 41-86 be withdrawn.

Rejection of claims 1-6, 9-12, 14-16, 18, and 35-37 under 35 USC §103(a) as being unpatentable over Duhon and Warning System and Shteyn in view of Schnall

Claims 1-6, 9-12, 14-16, 18, and 35-37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Duhon and Warning System and Shteyn in view of Schnall. Regarding claim 1, the cited art does not teach or suggest, *inter alia*, "A system for monitoring modifications on a plurality of elements in a credit reporting database, the modifications being at least partially definable by a user, the system comprising: ... the computer program adapted to continuously monitor the elements of the credit reporting database for modifications to at least one element selected by the user; wherein the system is capable of generating a credit report for the user and when at least one of said modifications occurs, sending a notification to the user substantially contemporaneously with when said at least one modification occurs, to the user that at least one modification has occurred." as recited in amended claim 1 of the present application (emphasis added).

The Office Action recites that "Duhon, Warning Systems and Shteyn do not explicitly teach adapted to continuously monitor however Schnall does teach this limitation at parg. 28,[,] lines 4-8." Paragraph 28, lines 4-8 of Schnall recites "Guarantor alert module 218 may be initialized and executed on a periodic basis such as one or more schedule time intervals each day or continuous basis each time an update is applied to loan database." "Loan database 220 includes raw data on loans made by the lending institution (such as loan information 102) and may also includes data from credit reporting agencies (such as credit information 105) imported through communication connection 208." Schnall, paragraph 24, lines 11-15. The loan information 102 may be regularly updated. Schnall, paragraph 19, line 8. The credit information 105 includes information retrieved from one or more credit reporting agencies. Schnall, Paragraph 18, lines 7-10.

Since Schnall is obtaining credit information from credit reporting agencies, Schnall is not monitoring the elements of a credit reporting database. Specifically, Schnall does not teach or suggest that its loan monitoring system has direct access to a credit reporting database. Assignee believes that only three organizations in the United States, Experian, TransUnion, and Equifax (the Assignee), have direct access to consumer credit reporting data. Without direct access to a credit reporting database, Schnall can only monitor the credit information it receives on a schedule, e.g., daily, weekly, etc. Moreover, if Schnall does not have direct access to consumer credit reporting data, e.g., a credit reporting database, then Schnall cannot "continuously monitor the elements of the credit reporting database for modifications ..." as recited in claim 1 (emphasis added).

A *prima facie* case of obviousness under 35 U.S.C. §103(a) requires that all claim limitations be taught or suggested by the prior art. *In re* Royka, 490 F.2d 981 (C.C.P.A. 1974). As shown above, Schall does not teach or suggest "continuously monitoring" credit reporting data, therefore, Schall cannot teach or suggest "continuously monitor the elements of the credit reporting database for modifications" as recited in amended claim 1 of the present application. Since Schall cannot continuously monitor the credit reporting database, the proposed combination of prior art cannot send "a notification to the user substantially contemporaneously with when said a least one modification occurs, ..." as recited in amended claim 1. Thus, not all of the elements of claim 1 are taught or suggested by the cited references, and the Office Action fails to make a *prima facie* case of obviousness.

Regarding independent claim 5 of the present application, which similarly to claim 1, recites "continuously monitoring" and "notifying the user substantially contemporaneously with when the changes occurs about the change to the at least one credit related data element." Thus, for similar reasons as stated above with respect to claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 5.

Regarding independent claim 12 of the present application, which similarly to claim 1, recites "continuously monitoring" and "notifying the user substantially contemporaneously with when the credit related data element is detected in the credit file." Thus, for similar reasons as

stated above with respect to claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 12.

Accordingly, it is respectfully submitted that independent claims 1, 5 and 12, and their dependent claims 2-4, 6-11, 13-18, and 35-37, respectively, are allowable over the references of record. Hence, for at least these reasons, the undersigned representative respectfully requests that the rejection of claims 1-6, 9-12, 14-16, 18, and 35-37 under 35 U.S.C. §103(a) be withdrawn.

Rejection of claims 19, 20, and 38 under 35 USC §103(a) as being unpatentable over Warning System and Duhon and Shteyn in view of Schnall

Regarding independent claim 19 of the present application, which similarly to claim 1, recites "continuous monitoring" and "generating a notification to the user substantially contemporaneously with when a change is detected; ..." Thus, for similar reasons as stated above with respect to claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 19. Therefore, the undersigned representative will not address the arguments with respect to these claims and reserves the right to address these arguments at a later time.

For at least these reasons, independent claim 19, as well as dependent claims 20 and 38, are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 19, 20, and 38 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 7 and 13 under 35 USC §103(a) as being unpatentable over Duhon and Early Warning and Shteyn in view of Schnall and further in view of ID Guard

Since claims 7 and 13 are dependent on allowable claims 5 and 12, respectively, and since ID Guard does not cure the deficiencies of these claims, dependent claims 7 and 13 are allowable as well. Therefore, the undersigned representative will not address the arguments with respect to these claims and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claims 7 and 13 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 7 and 13 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 8 under 35 USC §103(a) as being unpatentable over Duhon and Early Warning and Shteyn in view of ID Guard in view of Schnall and further in view of Privacy Guard

Since claim 8 is dependent on allowable claim 5, and since neither ID Guard nor Privacy Guard cure the deficiencies of claim 5, dependent claim 8 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 8 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 8 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 17 under 35 USC §103(a) as being unpatentable over Duhon and Early Warning and Shteyn in view of Schnall and further in view of Soups Up

Since claim 17 is dependent on allowable claim 12, and since Soups Up does not cure the deficiencies of claim 12, dependent claim 17 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 17 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 17 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 21 under 35 USC §103(a) as being unpatentable over Early Warning and Duhon and Shteyn in view of Schnall and further in view of Privacy Guard

Since claim 21 is dependent on allowable claim 19, and since Privacy Guard does not cure the deficiencies of claim 19, dependent claim 21 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 21 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 21 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 26-34 under 35 USC §103(a) as being unpatentable over Early Warning and Credit Check and Shteyn in view of Schnall

Regarding independent claim 26 of the present application, which similarly to claim 1, recites "continuous monitoring" and "communication to the user substantially contemporaneously with when a change to at least one credit-related data element is detected;" Thus, for similar reasons as stated above with respect to claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 26.

For at least these reasons, independent claim 26, as well as dependent claims 27-34 and 40 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 26-34 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 22-24 and 39 under 35 USC §103(a) as being unpatentable over Early Warning and ID Guard and Duhon and Shteyn in view of Schnall

Regarding independent claim 22 of the present application, which similarly to claim 1, recites "continuously monitoring" and "notifying the customer substantially contemporaneously with when the changes are detected about the changed data;" Thus, for similar reasons as stated above with respect to claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 22.

For at least these reasons, independent claim 22, as well as dependent claims 23-25 and 39, are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 22-24 and 39 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 25 under 35 USC §103(a) as being unpatentable over Early Warning and ID Guard and Duhon and Shteyn in view of Privacy Guard and further in view of Schnall

Since claim 25 is dependent on allowable claim 22, and since Privacy Guard does not cure the deficiencies of claim 22, dependent claim 25 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 25 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 25 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 40 under 35 USC §103(a) as being unpatentable over Early Warning and Credit Check and Shteyn in view of Schnall and further in view of Banarjee

Since claim 40 is dependent on allowable claim 26, and since Babarjee does not cure the deficiencies of claim 26, dependent claim 40 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 40 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 40 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 41-49, 52-57, 59-61, 63, 64, and 70-73 under 35 USC §103(a) as being unpatentable over Duhon and Early Warning and Shteyn

Regarding independent claims 41, 47, 56, and 70 of the present application, these independent claims recite variations of the "continuously monitor" and "sending a notification substantially contemporaneously ..." limitations recited in claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claims 41, 47, 56, and 70.

For at least these reasons, independent claims 41, 47, 56, and 70, as well as dependent claims 42-46, 48-55, 57-64, and 71-75 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 41-49, 52-57, 59-61, 63, 64, and 70-73 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 50 and 58 under 35 USC §103(a) as being unpatentable over Duhon and Early Warning and Shteyn in view of ID Guard

Since claims 50 and 58 are dependent on allowable claims 47 and 56, respectively, and since ID Guard does not cure the deficiencies of claims 47 and 56, dependent claims 50 and 58 are allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claims 50 and 58 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 50 and 58 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 51, 74, and 75 under 35 USC §103(a) as being unpatentable over Duhon and Early Warning and Shteyn in view of ID Guard and further in view of Privacy Guard

Since claims 51, 74, and 75 are dependent on allowable claims 47 and 70, respectively, and since ID Guard and Privacy Guard do not cure the deficiencies of claims 47 and 70, dependent claims 51, 74, and 75 are allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claims 51, 74, and 75 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 51, 74, and 75 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 62 under 35 USC §103(a) as being unpatentable over Duhon and Early Warning and Shteyn in view of Soups Up

Since claim 62 is dependent on allowable claim 56, and since Soups Up does not cure the deficiencies of claim 56, dependent claim 62 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 62 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 62 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 65-67 and 69 under 35 USC §103(a) as being unpatentable over Early Warning and Duhon and Shteyn

Regarding independent claim 65 of the present application, which similarly to claim 1, which recites "continuously monitoring," "generating a first notification to the user substantially contemporaneously with when a first change to the at least one credit related data element is detected" and "generating a second notification to the user substantially contemporaneously with when a second change to the at least one credit related data element is detected." Thus, for similar reasons as stated above with respect to claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 65.

For at least these reasons, independent claim 65, as well as dependent claims 66-69 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 65-67 and 69 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 68 under 35 USC §103(a) as being unpatentable over Early Warning and Duhon and Shteyn in view of Privacy Guard

Since claim 68 is dependent on allowable claim 65, and since Privacy Guard does not cure the deficiencies of claim 65, dependent claim 68 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 68 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 68 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claims 76-85 under 35 USC §103(a) as being unpatentable over Early Warning and Credit Check and Shteyn

Regarding independent claim 76 of the present application, which similarly to claim 1, recites "continuously monitoring," "communication to the user substantially contemporaneously with when a first change to at least one credit-related data element is detected" and "communication to the user substantially contemporaneously with when a second change to the at least one credit-related data element is detected." Thus, for similar reasons as stated above with respect to claim 1, the Office Action fails to make a *prima facie* case of obviousness with respect to claim 76.

For at least these reasons, independent claim 76, as well as dependent claims 77-86 are patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claims 76-85 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Rejection of claim 86 under 35 USC §103(a) as being unpatentable over Early Warning and Credit Check and Shteyn in view of Banerjee

Since claim 86 is dependent on allowable claim 76, and since Banerjee does not cure the deficiencies of claim 76, dependent claim 86 is allowable as well. Therefore, the undersigned

representative will not address the arguments with respect to this claim and reserves the right to address these arguments at a later time.

For at least these reasons, dependent claim 86 is patentable over the cited art. Accordingly, it is respectfully requested that the rejection of claim 86 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

CONCLUSION

The foregoing is submitted as a full and complete Response to the non-final Office Action mailed February 11, 2005, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (202)508-5843 is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1458, and please credit any excess fees to such deposit account.

Respectfully submitted,

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